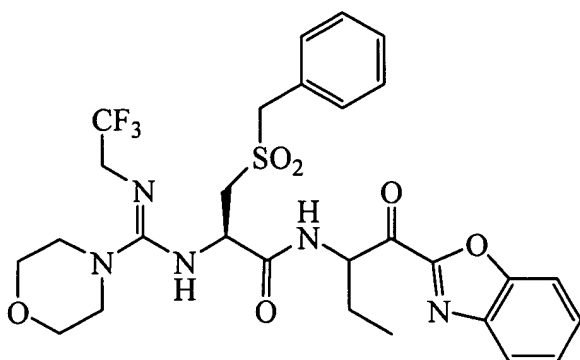


II. Claims 1-27, drawn to compounds, compositions and methods wherein R1, R1a, R2, R3, R4, R4a, and E does contain a heterocyclic group, classified in class/subclass numerous depending on the elected species.

The Examiner stated that the inventions of Groups I and II are distinct because “[t]hey do not possess a SUBSTANTIAL COMMON CORE seen to be essential to the utility by itself, nor is the core novel, hence, Groups I and II fail to meet both criteria for Markush type claims.” The Examiner further stated “there are multiple patentably distinct inventions wherein a reference anticipating one would not necessarily render the other obvious and to search all the instant compounds in a single application would present an undue burden on the examiner.”

Applicants elect Group II with traverse. The Applicants further elect the species having the following structure:



and referenced in the application as Example 4. Claims 1-5, 7, 11-14 and 18-27 read on the elected species.

Applicants respectfully traverse the restriction requirement for the following reasons. The Applicants submit that the Examiner may not compel an applicant to narrow the scope of a generic claim pursuant to a restriction requirement. Decisions by the Patent and Trademark Office Board of Patent Appeals and its reviewing court clearly hold that a restriction requirement which compels an applicant to divide a generic claim for the purposes of excising non-elected subject matter is improper and that such amounts

to a rejection. The Applicants cite *In re Haas II*, 580 F.2d 461, 198 USPQ 334 (CCPA 1978) and *In re Weber*, 580 F.2d 455, 198 USPQ 331 (CCPA 1978), in support of this position. The court in *In re Weber*, summarized the law as follows:

As a general proposition, an applicant has a right to have each claim examined on the merits. If an applicant submits a number of claims, it may well be that pursuant to a proper restriction requirement, those claims will be dispersed to a number of applications. Such action would not affect the right of the applicant eventually to have each of the claims examined in the form he considers to best define his invention. If, however, a single claim is required to be divided up and presented in several applications, that claim would never be considered on the merits. The totality of the resulting fragmentary claims would not necessarily be the equivalent of the original claim. Further, since the subgenera would be defined by the examiner rather than by the applicant, it is not inconceivable that a number of the fragments would not be described in the specification.

In *In re Haas I* the examiner withdrew two generic compound claims from further consideration on the grounds that they included multiple patentably distinct inventions. At the end of the prosecution a species claim was allowed along with a narrower generic claim encompassing only those compounds similar to the allowed species. (Please note the similarities between the prosecution history in *In re Haas* and that of the present application.) The applicant filed a petition under Rule 144 (petition denied), requested reconsideration (reconsideration denied), and subsequently took the issue to the Board of Appeals, which held there were no statutory grounds for their appellate jurisdiction.

On appeal from the Board's decision, the Court of Custom and Patent Appeals held that an adverse action of this nature is a rejection and denial of substantive rights, review of which must fall within the jurisdiction of the Board. The Court remanded the case to the Board, which remanded the case to the examiner and the examiner then finally

rejected the claims for misjoinder of invention under 35 U.S.C. § 121. On appeal the Board affirmed the examiner's rejection. On appeal from the decision of the Board affirming the final rejection under § 121, the Court of Customs and Patent Appeals (In re Haas II) reversed on authority of In re Weber and held that "§ 121 does not provide a basis for the rejection of a claim."

In Ex parte Holt, 214 USPQ 381 (Bd. App. 1982), the Board of Appeals followed In re Weber and In re Haas II and granted relief to the Appellant on the basis that 35 U.S.C. § 121 does not give the Patent Office the authority to reject or otherwise refuse to examine a claim. The Board declared, "It is clear from Haas I that regardless of the language employed by the examiner, the refusal to examine a claim is, in effect, a rejection of that claim." (Emphasis added.)

In light of In re Weber and In re Haas, the Patent and Trademark Office revised restriction practice with respect to generically claimed inventions. The proper procedure for restricting a generic claim is delineated in § 803.02 of the M.P.E.P. In this regard the Appellants direct the Board to M.P.E.P. § 803.02, paragraphs 4 and 5, which states:

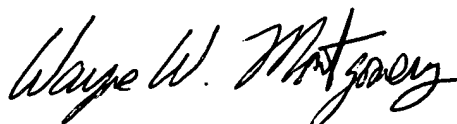
As an example, in the case of an application with a Markush-type claim drawn to the compound C-R, wherein R is a radical selected from the group consisting of A, B, C, D and E, the examiner may require a provisional election of a single species, CA, CB, CC, CD or CE. The Markush-type claim would then be examined fully with respect to the elected species and any species considered to be clearly unpatentable over the elected species. If on examination the elected species is found to be anticipated or rendered obvious by prior art, the Markush-type claim and claims to the elected species shall be rejected, and claims to the non-elected species would be held withdrawn from further consideration. As in the prevailing practice, a second action on the rejected claims would be made final. On the other hand, should no prior art be found that

anticipates or renders obvious the elected species, the search of the Markush-type claim will be extended. (Emphasis added.)

Hence, the examiner may require an applicant to provisionally elect a species for examination. If the elected species is ultimately found patentable, then the examination is extended to the provisionally withdrawn subgenera, in this instance the compounds of Formula I having a non-imidazole or non-indole moiety. If, on the other hand, the elected species is found unpatentable, the generic claim and claims to the elected species are rejected and claims to the non-elected subgenera are withdrawn from further consideration. The applicant may overcome this rejection by amending the generic claim to exclude the unpatentable species. If after reconsideration of the amended claim a second species is found unpatentable, the claim is rejected and the action is made final. Thus, the prior art search is not extended unnecessarily and the applicant's invention, as he or she contemplates it, is examined on the merits.

In conclusion, the Patent and Trademark Office Board of Patent Appeals and its reviewing court have clearly and unequivocally held that the Patent Office may not require the narrowing of a generic claim pursuant to a restriction requirement. Accordingly, the Applicants respectfully request that the remainder of their generically claimed invention be examined on the merits and that, in the absence a statutory or judicially created basis for forming a rejection, Claims 1-27 be allowed.

Respectfully submitted,



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July 15, 2005

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